

O-074-14

**THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 2008 AND  
TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1113370  
FOR THE TRADE MARK**



**IN CLASSES 35 AND 36**

**IN THE NAME OF  
OBSCHESTVO S OGRANICHENNOJ OTVETSTVENNOST'JU "BANK  
FININVEST"**

**AND THE APPLICATION FOR THE GRANTING OF PROTECTION THEREOF IN  
THE UNITED KINGDOM**

**AND**

**THE OPPOSITION THERETO  
UNDER NO. 72460  
BY  
FINANZIARIA D'INVESTIMENTO FININVEST S.P.A.**

## BACKGROUND

1) Obshchestvo s ogranichennoj otvetstvennost'ju "BANK FININVEST" ('the holder') is the holder of the International Registration ('IR') for the following trade mark:



Colours claimed: Red, white and blue.

Disclaimer: Registration of this mark shall give no right to the exclusive use of the word "BANK".

2) The United Kingdom was designated in respect of the IR on 21 February 2012 for the following services in Classes 35 and 36:

**Class 35:** *Commercial information agencies; cost price analysis; auditing; computerized file management; accounting; invoicing; marketing studies; business information; commercial information and advice for consumers [consumer advice shop]; business investigations; marketing research; business management and organization consultancy; personnel management consultancy; business organization consultancy; business management consultancy; professional business consultancy; organization of exhibitions for commercial or advertising purposes; business appraisals; payroll preparation; data search in computer files for others; sponsorship search; business management assistance; commercial or industrial management assistance; economic forecasting; document reproduction; compilation of statistics; compilation of information into computer databases; business inquiries; systemization of information into computer databases; tax preparation; drawing up of statements of accounts; commercial administration of the licensing of the goods and services of others; administrative processing of purchase orders; price comparison services; outsourcing services [business assistance]; efficiency experts.*

**Class 36:** *Credit bureaux; debt collection agencies; real estate agencies; financial analysis; hire-purchase financing; savings bank; rent collection; issuing of travellers' checks [cheques]; issuance of credit cards; issue of tokens of value; capital investments; insurance information; financial information; clearing, financial; insurance consultancy; financial consultancy; stock exchange quotations; financial management; exchanging money; debit card services; credit card services; home banking; factoring; organization of collections; antique appraisal; jewellery appraisal; stamp appraisal; real estate appraisal; numismatic appraisal; art appraisal; financial evaluation [insurance, banking, real estate]; repair costs evaluation [financial appraisal]; electronic funds transfer; bail-bonding; stocks and bonds brokerage; real estate brokers; insurance brokerage; loans [financing]; lending against security; check [cheque] verification; charitable fund raising; financial sponsorship; mortgage banking; instalment loans; accident insurance underwriting; fire insurance underwriting; health insurance underwriting; insurance underwriting; life insurance underwriting; marine insurance underwriting; actuarial services;*

*banking; retirement payment services; fiduciary; mutual funds; financing services; safe deposit services; deposits of valuables; fiscal assessments.*

3) The IR was published for opposition purposes in the Trade Marks Journal on 31 August 2012 and notice of opposition was subsequently filed by Finanziaria d'Investimento Fininvest S.p.A. ('the opponent'). The opponent claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). One earlier community trade mark ('CTM') registration is relied upon, details of which are as follows:

CTM details	Services relied upon
<p><b>CTM: 8151664</b></p> <p><b>FININVEST</b></p> <p><b>Filing date: 12 March 2009</b></p> <p><b>Date of entry in the register: 24 September 2009</b></p>	<p><b>Class 35:</b> Advertising; business management; business administration; office functions.</p> <p><b>Class 36:</b> Insurance; financial affairs; monetary affairs; real estate affairs.</p> <p><b>Class 41:</b> Education; providing of training; entertainment; sporting and cultural activities.</p>

4) The opponent's CTM has a filing date of 12 March 2009 and completed its registration procedure on 24 September 2009. The consequences of these dates are, in relation to the holder's mark, that i) the opponent's CTM is an earlier mark in accordance with section 6 of the Act and ii) the CTM is not subject to the proof of use conditions contained in section 6A of the Act.

5) In support of its opposition the opponent states, *inter alia*, the following:

'The International Registration (UK) is for the mark BANK FININVEST in combination with a logo. The publication shows that registration of this mark shall give no right to the exclusive use of the word BANK. The distinctive word element of the mark is therefore FININVEST which is the entirety of the Opponent's earlier community trade mark registration. It is therefore likely that customers seeing the mark will assume that there is an economic connection with the Opponent's business carried out under its FININVEST mark.'

6) In relation to the respective services, the opponent states:

'The lists of services in classes 35 and 36 of the Opponent's registration comprise the class headings from the 9<sup>th</sup> Edition of the Nice Classification of Goods and Services which was published in June 2006 and in force from 1 January 2007. The 9<sup>th</sup> Edition was in force when the Opponent's CTM application no.8151664 was filed on 12 March 2009. The Opponent's use of the class heading in classes 35 and 36 is in accordance with the Communication No. 4/03 of the President of the Office of 16 June 2003.'

Following the judgment in the case C-307/10 *The Chartered Institute of Patent Attorneys v Registrar of Trade Marks* (“IP TRANSLATOR”) the President of the Office issued Communication No. 2/12 of the President of the Office of 20 June 2012. In accordance with V. of Communication No. 2/12 the Opponent’s community trade mark registration covers all services in classes 35 and 36.

There is therefore identity of services with the published International Registration (UK). In addition, or alternatively, the published services for International Registration (UK) are similar to the goods and services of the earlier trade mark.’

7) The holder filed a counterstatement in which it states, *inter alia*, the following:

‘ ...

2. It is denied that the Holder’s mark is similar to the Opponents’ mark.

...

4. The existence of the disclaimer for BANK does not automatically result in a finding of distinctiveness or dominance for the remainder of the mark which is not disclaimed.

5. Nor does the existence of the disclaimer result in the total erasure of the word BANK from the perception which the average consumer would receive of the Holder’s mark: no consumer, let alone the average consumer, would be expected to take account what disclaimers existed on the register of trade marks to guide him as to what part of the mark is meant to function as the indicator of origin. The Holder’s mark should therefore be compared in its totality with the mark of the Opponents, regardless of the disclaimer.

6. Moreover, the totality of the Holder’s mark is not the two words BANK and FININVEST. It contains a third element, of a device. This device must not be discounted from the assessment; to do so would not be to apply the test for *overall* impression.....

...

9. No statement can be given to either admit or deny the identity or similarity of any of the services of the Holder with any of the goods and services of the Opponents’ mark.

10. This is because the specification of the Opponents’ mark consists only of class headings; consequently it does not meet the requirement of the Trade Marks Directive for sufficiently clear and precise specification.

11. That requirement must be met by the specification itself: the CJEU in IP TRANSLATOR: “*An application for registration which does not make it possible to establish whether, by using a particular class heading of the Nice*

*Classification, the applicant intends to cover all or only some of the goods in that class cannot be considered sufficiently clear and precise”.*

12. No official policy can transform an unclear and imprecise specification into one which is clear and precise: the CJEU in IP TRANSLATOR: *“a situation in which the extent of protection conferred by the trade mark depends on the approach to interpretation adopted by the competent authority and not on the actual intention of the applicant runs the risk of undermining legal certainty both for the applicant and for third party economic operators.”*

13. Because a) the specification of the Opponents’ mark is neither clear nor precise and b) no official policy can deem it to be so, the Opponents cannot rely on either OHIM Communication Nos 3/04 and 2/12 to transform their specification into a clear and precise one. In particular, they cannot rely on these Communications to deem identity of all the parties’ services in classes 35 and 36.

...’

8) Only the opponent filed evidence and submissions during the evidential rounds. The matter came to be heard before me on Thursday 31 October 2013, by telephone conference. Mr Alasdair Hume of Ancient Hume Limited represented the opponent. Ms Claire Lazenby, Registered Trade Mark Attorney, represented the holder.

### **The Opponent’s evidence**

9) The evidence consists of a witness statement dated 14 March 2013 in the name of the opponent’s Italian Trade Mark Attorney, Ms Paola Pagani. At paragraph 2 of the statement, Ms Pagani states that on 6 August 2012 she wrote to the holder’s attorney based in Russia, Ms Elena Solovyova. She further states that, in a without prejudice letter attached to an e-mail, she asked that Ms Solovyova’s client renounce the International Registration and refrain from using the mark BANK FININVEST in Latin characters. She also states she made it clear that she had instructions to file further oppositions. At Exhibit PP1 is a copy of the relevant e-mail (without attachments). The e-mail simply states ‘Please refer to the attached file’.

## **DECISION**

### **Section 5(2)(b)**

10) This section of the Act states:

“5. (2) A trade mark shall not be registered if because –

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11) The leading authorities which guide me in approaching the assessment of the likelihood of confusion are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the

distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

12) At the hearing, Mr Hume accepted that the copy of the draft decision (filed with the opponent's submissions) concerning refusal of the holder's French designation of International Registration No. 1113370 further to an opposition by the opponent, would not be binding upon me.

### Consideration of the respective services

13) The respective services are:

Services relied upon by the Opponent	Holder's services
<p><b>Class 35:</b> Advertising; business management; business administration; office functions.</p> <p><b>Class 36:</b> Insurance; financial affairs; monetary affairs; real estate affairs.</p> <p><b>Class 41:</b> Education; providing of training; entertainment; sporting and cultural activities.</p>	<p><b>Class 35:</b> Commercial information agencies; cost price analysis; auditing; computerized file management; accounting; invoicing; marketing studies; business information; commercial information and advice for consumers [consumer advice shop]; business investigations; marketing research; business management and organization consultancy; personnel management consultancy; business organization consultancy; business management consultancy; professional business consultancy; organization of exhibitions for commercial or advertising purposes; business appraisals; payroll preparation; data search in computer files for others; sponsorship search; business management assistance; commercial or industrial management assistance; economic forecasting; document reproduction; compilation of statistics; compilation of information into computer databases; business inquiries;</p>

	<p>systemization of information into computer databases; tax preparation; drawing up of statements of accounts; commercial administration of the licensing of the goods and services of others; administrative processing of purchase orders; price comparison services; outsourcing services [business assistance]; efficiency experts.</p> <p><b>Class 36:</b> Credit bureaux; debt collection agencies; real estate agencies; financial analysis; hire-purchase financing; savings bank; rent collection; issuing of travellers' checks [cheques]; issuance of credit cards; issue of tokens of value; capital investments; insurance information; financial information; clearing, financial; insurance consultancy; financial consultancy; stock exchange quotations; financial management; exchanging money; debit card services; credit card services; home banking; factoring; organization of collections; antique appraisal; jewellery appraisal; stamp appraisal; real estate appraisal; numismatic appraisal; art appraisal; financial evaluation [insurance, banking, real estate]; repair costs evaluation [financial appraisal]; electronic funds transfer; bail-bonding; stocks and bonds brokerage; real estate brokers; insurance brokerage; loans [financing]; lending against security; check [cheque] verification; charitable fund raising; financial sponsorship; mortgage banking; instalment loans; accident insurance underwriting; fire insurance underwriting; health insurance underwriting; insurance underwriting; life insurance underwriting; marine insurance underwriting; actuarial services; banking; retirement payment services; fiduciary; mutual funds; financing services; safe deposit services; deposits of valuables; fiscal assessments.</p>
--	--

**Is there identity between the respective services on the basis of use of class headings?**

14) Mr Hume has stated that the list of services in classes 35, 36 and 41 of the opponent's CTM comprise the class headings from the 9<sup>th</sup> Edition of the Nice



Classification of Goods and Services (which was in force when the Opponent's CTM was filed on 12 March 2009). He submitted that, by using all of the class headings the opponent's intention was to cover all services in those classes. In this regard, Mr Hume referred me to Communication Nos. 4/03 and No. 2/12 of the President of the Office for Harmonization in the Internal Market. The former Communication was in force at the time of filing of the opponent's application for its CTM; it states, inter alia, the following:

"The 34 classes for goods and the 11 classes for services comprise the totality of all goods and services. As a consequence of this the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class."

15) The latter Communication was issued further to the judgment in *The Chartered Institute of Patent Attorneys v Registrar of Trade Marks ('IP TRANSLATOR')* C-307/10. Mr Hume referred me, in particular, to point V. of that Communication which states:

"As regards Community trade marks registered before the entry into force of the present Communication which use all the general indications listed in the class heading of a particular class, the Office considers that the intention of the applicant, in view of the contents of the previous Communication 4/03, was to cover all the goods or services included in the alphabetical list of that class in the edition in force at the time when the filing was made."

16) In light of the above, Mr Hume submitted that the opponent's CTM should be taken to cover all services in the classes for which it is registered and accordingly, the respective services are identical. However, in the event that I was not minded to find identity on the aforementioned basis, Mr Hume contended that the respective services are still identical and/or similar on the basis of the normal and natural meanings of the respective terms.

17) Ms Lazenby disputed that identity or similarity of services could be founded on either of the bases submitted by Mr Hume. She contended that the terms in the opponent's specification are class headings which have variable meanings and, as such, are imprecise and unclear. In her submission, no practice statement can transform such a specification into one which is precise and clear; this requirement must be met by the wording of the specification itself, in accordance with the judgment in *IP TRANSLATOR*. In her view, as a consequence of the lack of precision and clarity in the opponent's specification, no comparison can be made between the respective services. However, she submitted that, in the event that I was minded to find sufficient precision and clarity, then I should make the comparison on the basis of the natural meaning of those terms which should be construed narrowly.

18) I am not persuaded by Mr Hume's first line of argument that I should find identity purely on the basis that the opponent's CTM consists of class headings which, by virtue of the contents of the two Communications issued by the Office for Harmonization in the Internal Market, means that those headings cover all services in those classes. I agree with Ms Lazenby's submission that it is necessary to look to

the wording of the specification itself and whether it is clear and precise, in order to decide what services are covered by that specification. In *IP TRANSLATOR*, the court stated, (my emphasis added):

“Therefore the answer to the questions referred is that:

Directive 2008/95 must be interpreted as meaning that it requires the goods and services for which the protection of the trade marks is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.”

The court continued to state:

“Directive 2008/95 must be interpreted as meaning that it does not preclude the use of the general indications of the class headings of the Nice Classification to identify the goods and services for which the protection for the trade mark is sought, provided that such identification is sufficiently clear and precise;”

19) In light of the above, I consider it appropriate to look to the opponent’s specification itself and to determine whether it is sufficiently clear and precise taking into account the natural and ordinary meaning of the terms. In the event that I find sufficient clarity and precision, I will then compare the respective services on the basis of their natural and ordinary meanings.

#### **Is the opponent’s specification clear and precise?**

20) In relation to understanding what terms used in specifications mean/cover I bear in mind the comments of Jacob J in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

‘When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade.’

21) In *Beautimatic International Ltd v. Mitchell International Pharmaceuticals Ltd and Another* (‘*Beautimatic*’) [2000] FSR 267 Neuberger J held that the words must be given their natural meaning, subject to their being construed within their context; they must not be given ‘an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor’. However, I must also bear in mind the comments of Jacob J in *Avnet Incorporated v Isoact Ltd* (‘*Avnet*’) [1998] FSR 16:

‘In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.’

22) Further, in *YouView TV Ltd v Total Ltd* (‘*YouView*’) [2012] EWHC 3158 (Ch) at [12] Floyd J said:

‘... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks)* (IP TRANSLATOR) [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.’

23) I will deal firstly with the opponent’s terms in class 35, which, for ease of reference, are:

*Advertising; business management; business administration; office functions.*

24) Advertising services are those which are primarily provided to businesses in order to assist them in publicising their goods and/or services with the primary objective of attracting custom for those businesses. Such services, in my view, would plainly involve communicating in some way, whether by radio, television, billboards, newspaper adverts etc., the nature of the goods/services and their claimed benefits/advantages to the consumer.

25) ‘Business management’ refers to services which are provided to businesses to assist them in co-ordinating and controlling their resources. Such services would include the provision of assistance as regards using resources efficiently and effectively and helping to achieve short and long-term objectives and goals.

26) ‘Business administration’, in my view, refers to services which are provided to businesses in order to assist them in their day-to-day administrative tasks in order to facilitate efficient operations.

27) I now turn to ‘Office functions’. An office is a place where business is conducted. ‘Function’ refers to an activity which is natural to, or is the purpose of a person or a thing<sup>1</sup>. It follows that, in my view, ‘office functions’ refer to services which are provided to a business in order to assist it in fulfilling routine activities and would include services such as, for example, the filing of documents, data-entry, photocopying and transcription services.

28) Turning to the opponent’s terms in class 36, these are:

*Insurance; financial affairs; monetary affairs; real estate affairs*

29) ‘Insurance’ refers to services which are provided to compensate individuals/businesses for specific losses/damage of/to personal property, health, etc.

---

<sup>1</sup> 2000 ‘Function’ in *Collins English Dictionary*, Collins, London, United Kingdom. Accessed: 10 February 2014, from Credo Reference

30) 'financial affairs' and 'monetary affairs' are both, to my mind, services concerned primarily with the management of money. They would include, for example, services for the purpose of saving, generating, investing, borrowing, loaning and exchanging money and the provision of advice relating to the same.

31) Turning to 'real estate affairs', 'real estate' describes property consisting of land and buildings. Plainly this term would include, for example, the services of an estate agent such as rental and valuation of land and buildings and collection of rent from tenants etc.

32) I find that all of the opponent's terms are sufficiently clear and precise to enable them to be compared with the holder's services. It will be apparent that I have not considered the clarity and precision of the opponent's services in class 41. I do not consider this is necessary for reasons which will become apparent.

### **Comparison of services**

33) The leading authorities as regards determining similarity between goods and services are considered to be *British Sugar Plc v James Robertson & Sons Ltd* ('*Treat*') [1996] R.P.C. 281 and *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 ('*Canon*'). In the latter case, the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

34) Whether goods/services are complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), will depend on whether there exists a close connection or relationship such that one is important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

'It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the

other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).’

35) When comparing the respective services, if a term clearly falls within the ambit of a term in the competing specification then identical services must be considered to be in play (see *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) ('Merici')* Case T-133/05).

36) There is no evidence before me on the matter of similarity or identity and therefore, when conducting the assessment, I will do so on the basis of factors which are self-evident and obvious, based on the natural and ordinary meaning of the terms in the respective specifications, taking into account the parties’ submissions. I remind myself that, in doing so, I must be cautious not to give a term an overly broad/liberal interpretation (*Avnet*) or an overly narrow interpretation (*Beautimatic, YouView*). I will make the comparison by addressing the services in each class within the holder’s specification in turn, and, where appropriate and for the sake of expediency, grouping certain terms together (*Separode Trade Mark* BL O-399-10). I will compare those terms to the services in the opponent’s specification which represent its strongest case.

The holder’s class 35 services:

37) *cost price analysis; auditing; computerized file management; accounting; invoicing; business information; business investigations; business management and organization consultancy; personnel management consultancy; business organization consultancy; business management consultancy; professional business consultancy; business appraisals; payroll preparation; data search in computer files for others; business management assistance; commercial or industrial management assistance; economic forecasting; document reproduction; compilation of statistics; compilation of information into computer databases; business inquiries; systemization of information into computer databases; tax preparation; drawing up of statements of accounts; commercial administration of the licensing of the goods and services of others; administrative processing of purchase orders; outsourcing services [business assistance]; efficiency experts.*

All of the holder’s services listed above can be described as business management/administration or office function services. As such, I consider them to fall within the ambit of the opponent’s *business management; business administration; office functions*. The respective services are identical in accordance with the *Merici* principle.

38) *Commercial information agencies; commercial information and advice for consumers [consumer advice shop];*

The above services will self-evidently involve the dissemination of commercial/business information. In my view there is a reasonable degree of similarity with the opponent's business management and business administration services which may also involve the provision of such information.

39) *marketing studies; marketing research.*

The ordinary meaning of these terms is the investigation into, and analysis of, matters relating to the promotion of goods and services to consumers. Ms Lazenby contended that whilst an advertising *agency* may provide such services, an undertaking providing *advertising* would not. However, given my earlier comments regarding the ordinary meaning of the opponent's *advertising*, it appears to me that the users and trade channels of the respective services may be the same and that their intended purpose is similar given that both are, in essence, concerned with assisting businesses to improve profitability through attracting custom. The respective services are reasonably similar.

40) *organization of exhibitions for commercial or advertising purposes.*

Mr Hume submitted that these services are similar to the opponent's '*organization and conducting of educational or recreational exhibitions*' which, in his view, would be covered by the terms in the opponent's class 41. I have not given a view as to whether those services would indeed be covered by the opponent's terms in its class 41 and nor do I consider it necessary to do so. In my view, the opponent has an equally strong, if not stronger case, in the form of its *advertising* services. Exhibitions are for the purpose of publicising information and/or products. The holder's services clearly state they are for the purpose of commerce or advertising. To my mind, this indicates that the exhibitions are for the purpose of, essentially, advertising the goods/services that an undertaking has to offer to potential customers. The respective services are similar in nature and intended purpose and may share the same trade channels and users. Accordingly, there is a reasonable degree of similarity with the opponent's *advertising*.

41) *Sponsorship search*

The ordinary meaning of this term is that they are services which assist in finding a suitable sponsor or assist a potential sponsor to find suitable sponsorship opportunities; a sponsor being an individual or business which is willing to provide financial funding to assist in the activities carried out by another, usually, in return for advertising. The core purpose is therefore to assist individuals in securing financial funds or to find advertising opportunities. On that basis, there is a degree of similarity with the opponent's *financial affairs* and *advertising*. The respective services are similar in nature, share an intended purpose and may share the same users. They are moderately similar to the holder's *sponsorship search* services.

42) *Price comparison services*

The ordinary meaning of this term is that they are services which provide information on the price of various goods and services in order to assist a consumer in deciding which provider to choose. It appears to me that there is some similarity with the

opponent's *financial affairs*, which would include the provision of financial advice. Such advice may include assisting a consumer to choose the most affordable bank account or mortgage etc. To that extent at least, the services share an intended purpose and the trade channels may overlap. In my view there is a low degree of similarity with the opponent's *financial affairs*.

The holder's class 36 services

43) *Real estate agencies; rent collection; real estate appraisal; real estate brokers.*

In light of my earlier comments as to the meaning of the opponent's *real estate* services, these are evidently identical to the holder's services in accordance with *Meric*.

44) *insurance information; insurance consultancy; accident insurance underwriting; fire insurance underwriting; health insurance underwriting; insurance underwriting; life insurance underwriting; marine insurance underwriting; insurance brokerage.*

It is self evident that the above services would fall within the ambit of the opponent's *Insurance* services. The services are identical (*Meric*).

45) *Credit bureaux; debt collection agencies; financial analysis; hire-purchase financing; savings bank; issuing of travellers' checks [cheques]; issuance of credit cards; issue of tokens of value; capital investments; financial information; clearing, financial; financial consultancy; stock exchange quotations; financial management; exchanging money; debit card services; credit card services; home banking; factoring; organization of collections; financial evaluation [insurance, banking, real estate]; repair costs evaluation [financial appraisal]; electronic funds transfer; bail-bonding; stocks and bonds brokerage; loans [financing]; lending against security; check [cheque] verification; charitable fund raising; financial sponsorship; mortgage banking; instalment loans; actuarial services; banking; retirement payment services; fiduciary; mutual funds; financing services; safe deposit services; deposits of valuables; fiscal assessments.*

Bearing in mind my earlier comments as to the meaning of the opponent's *financial affairs* and *monetary affairs*, I consider that all of the holder's services listed above would fall within the ambit of such services. The respective services are identical (*Meric*).

46) *antique appraisal; jewellery appraisal; stamp appraisal; numismatic appraisal; art appraisal.*

These services are all essentially concerned with the valuation of assets. They are, in my view, niche services requiring specialist expert knowledge and they do not naturally fall within the ambit of any of the opponent's services nor can I see any meaningful similarity within the parameters of the case law. There is no similarity with the opponent's services.

## **Average consumer and the purchasing act**

47) It is necessary to consider these matters from the perspective of the average consumer of the services at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of the services.

48) In her skeleton argument, Ms Lazenby stated, *inter alia*, the following:

‘12. The opponents have not factored in the level of attention the average consumer when selecting the services. The attention level will not merely be high; it will be the highest level of attention. Decisions on money, on for example comparing savings rates, are made very carefully.

13. The opponents have also not considered the identity of the average consumer. Whatever his identity, be he the man in the High Street needing to open a current account, or a company which needs facilities for daily currency exchange transaction of millions a year, he will always be careful as to the origins of the provider of the service he needs.’

49) Ms Lazenby further stressed these points to me at the hearing. For his part, Mr Hume accepted that an above average degree of attention would likely be paid by the average consumer, who in his view would primarily constitute businesses.

50) In my view, the respective services in class 35 will be primarily aimed at, and purchased by, businesses rather than the man in the street. In relation to the parties’ services in class 36, it is likely that the average consumer will consist both of businesses and the general public. Whilst the services at issue may vary greatly in price, given their nature, it is likely that the purchase will always involve a certain degree of contemplation on the part of the consumer. Ms Lazenby’s contention that the highest level of attention will be paid by the consumer may be well-founded for certain of the services. However, for the majority of the services, it is more likely, in my view, to vary from a reasonably high level of attention up to a high level of attention (i.e high, but not the highest). As for the manner in which the respective services are likely to be selected, this is likely to be primarily visual through perusal of websites or trade directories, although aural considerations are certainly not discounted.

## **Distinctive character of the earlier mark**

51) I must consider the distinctive character of the earlier mark. The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*).

52) No evidence of use has been filed by the opponent and therefore I have only the inherent level of distinctiveness to consider. The earlier mark is presented as the single word FININVEST in plain block capitals. Ms Lazenby submitted that the mark will be perceived as ‘finance’ and ‘investment’ by the average consumer and, as such, the mark was “not very original” bearing in mind the nature of the opponent’s services, and should be attributed the “lowest rung possible” of inherent distinctive



character. Not surprisingly, Mr Hume disagreed with this assessment. He submitted that Ms Lazenby’s contention as to how the opponent’s mark would be perceived was “contrived”. In his view, the mark would portray no meaning at all and accordingly was not low in distinctiveness.

53) FININVEST is not a dictionary word in the English language. Nevertheless, even invented words may be capable of evoking a concept if they consist of a combination of one or more recognisable words or resemble a recognisable word. When presented with a word, it is a natural instinct to attempt to make sense of it. The eye will tend to see what it wants to see (see, for example, *Usinor SA v OHIM*, Case T-189/05, paragraph 62). Bearing this in mind and the nature of certain of the opponent’s services (which may include, for example, ‘financial investment services’), I consider there to be some force in Ms Lazenby’s submission to the extent that I agree that the consumer may recognise the word INVEST within the mark. However, I am not persuaded that the FIN part of the mark will be perceived as ‘finance’. I have nothing before me, other than Ms Lazenby’s assertion, to suggest that FIN is a known abbreviation of the word ‘finance’. I have been unable to find any dictionary definition suggesting that FIN means finance and, in the absence of any evidence on the point, I come to the conclusion that it is unlikely to portray any meaning. It is, of course, necessary to assess the mark as a whole. Whilst I have found that the consumer may recognise and perceive the word INVEST, they will also appreciate that it forms part of the overall invented word FININVEST. Taking into account these factors, I do not agree with Ms Lazenby’s submission that the distinctiveness of the mark is very low. I consider the mark as a whole to be possessed of, at least, an average degree of inherent distinctive character in relation to the opponent’s services.

### Comparison of marks

Opponent’s mark	Holder’s mark
<b>FININVEST</b>	

54) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). Accordingly, there cannot be an artificial dissection of the marks, although, it is necessary to take into account any distinctive and dominant components.

55) The opponent’s mark consists of the single word FININVEST presented in plain block capitals. There are no dominant elements; the distinctiveness lies in the trade mark as a whole.

56) The holder’s mark consists of a round blue and white device element at the beginning of the mark followed by the two words BANK and FININVEST presented in a very slightly stylised font with BANK presented in red and FININVEST in blue. At the hearing, Mr Hume accepted that the presence of the disclaimer on the register

does not have any effect on my analysis of the holder's mark, as the average consumer will be unaware of it. He submitted that, whilst the word BANK and the device element cannot be disregarded, it is nevertheless the word FININVEST which is very much the dominant and distinctive element. Ms Lazenby disputed that the word FININVEST is the dominant and distinctive element of the holder's mark and, with reference to *Medion* contended that it is only in the unusual case that one element will dominate a mark; she stressed that the overall impression of the mark must be considered and, in that regard, the device and the word BANK play an important role. In particular, she contended that the word BANK plays an important part in the "origin function" as it signifies a place. I of course agree with Ms Lazenby that it is the overall impression of the mark which I must consider. Further it is clear to me from *Medion* that, whether one or more elements dominate that overall impression is to be determined on a case by case basis.

57) Dealing firstly with the device, this is a distinctive element. However, given its relative size and positioning, it is, in my view, less dominant than the words. As regards the words, I note Ms Lazenby's argument that the word BANK signifies origin as it is the name of a place. However, it is to be borne in mind that the role of a trade mark is to signify *trade* origin by means of a distinctive sign rather than merely to describe the *place* of origin. In this connection, BANK is clearly directly descriptive or indicative of the place where a number of the holder's services will be carried out (e.g. savings bank, mortgage banking, banking) and, in those circumstances, the word FININVEST, will be very much the more dominant and distinctive word which will contribute far more greatly to the *trade* origin message. Further, in respect of certain of the holder's services where BANK may not be indicative or directly descriptive, FININVEST will still be the more dominant and distinctive word on account of its relative size and invented nature.

58) In approaching the visual comparison, I bear in mind that, as the opponent's mark is registered in black and white, the colour in the holder's mark is not a distinguishing factor for the reasons given in *Specsavers International Healthcare Ltd v Asda Stores Ltd (No.2)* [2011] FSR 1. The device element and the word BANK in the holder's mark are both absent from the opponent's mark creating some visual difference. That said, the presence in both marks of the word FININVEST still results in a reasonably high degree of visual similarity.

59) From an aural perspective, the device in the holder's mark will not be pronounced. The word BANK in the holder's mark creates a degree of difference. However, the commonality of the word FININVEST (likely to be pronounced FIN-IN-VEST, with FIN to rhyme with 'TIN') creates a high degree of aural similarity.

60) Turning to the conceptual aspect, the device element in the holder's mark is rather abstract and is unlikely to establish any concept in the consumer's mind. 'BANK' is purely descriptive or indicative of the nature of a number of the holder's services; in the event that it contributes to the conceptual hook at all, it will be perceived as a financial establishment. Insofar as the invented word FININVEST evokes any concept (I have already indicated that the average consumer may perceive the word 'INVEST' within the mark), that concept will be the same for the respective marks. It follows that, insofar as the totality of either mark evokes any concept it will be highly similar.

61) There is a high degree of similarity between the marks overall.

### **Likelihood of confusion**

62) In deciding whether there is a likelihood of confusion I must take account of all of the above factors. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*), and;
- iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

63) There is no similarity between the opponent's services and the holder's *antique appraisal; jewellery appraisal; stamp appraisal; numismatic appraisal; art appraisal*. It follows that there can be no likelihood of confusion in respect of those services (*Waterford Wedgwood plc v OHIM-C-398/07*). The holder's other services are either identical, or similar to varying degrees, as already identified, to the opponent's services. The respective marks share a reasonably high degree of visual similarity and a high degree of aural similarity and insofar as the respective marks evoke any concept, this will be highly similar; there is a high degree of similarity between the marks overall. The earlier mark is possessed of, at least, an average level of inherent distinctive character. The average consumer will consist of businesses and the general public. The consumer may pay the highest level of attention during the purchase for certain of the services. However, for the most part the level of attention paid during the purchase is likely to vary from reasonably high to high (i.e. high, but not the highest).

64) Ms Lazenby contended that the marks would not be confused given the low degree of distinctiveness of the opponent's mark. She contended that the respective marks were not on par with, for example, device + PELICAN BANK and PELICAN, where the distinctiveness of PELICAN may give rise to confusion. I do not consider this submission to be of assistance. I have already concluded that the opponent's mark possesses at least an average level of distinctiveness. Further, whether there is a likelihood of confusion must be based on a multi-factorial assessment in respect of the actual marks before me.

65) Ms Lazenby further submitted that, whilst the consumer can be expected to retain only a recollection of the mark which is imperfect, he/she will nevertheless retain an imperfect recollection of the *whole* mark. Accordingly, the recollection would be of a three part mark. In my view, given the degree of attention that is likely to be paid during the purchasing act, there may be force in this submission. That said, taking into account all factors, even if the average consumer would not mistake one mark for other they are still likely, in my view, bearing in mind the high degree of

similarity between the marks and the identity and similarity between the services, to assume that the respective services emanate from the same or linked undertaking(s). There is a likelihood of confusion in respect of all of the holder's services which I have found to be identical or similar to the opponent's services.

**66) The opposition succeeds for all of the holder's services with the exception of antique appraisal; jewellery appraisal; stamp appraisal; numismatic appraisal; art appraisal.**

## **COSTS**

67) The opponent has been largely successful. Ms Lazenby disputed that adequate notice had been given prior to the opposition being filed and requested that the opponent submit a copy of the letter which had been attached to the e-mail exhibited to Ms Pagani's witness statement. I declined this request as I did not consider it was necessary. The reason for this being that, despite claiming to have had insufficient notice of the intended opposition, the holder has nevertheless opted to defend its trade mark application – as such, it has voluntarily joined the proceedings and must therefore be prepared to incur the potential cost implications associated with that course of action. As is stated in Tribunal Practice Notice 6 of 2008:

“Where an opposition is defended, the provision or otherwise of prior notice will not usually affect the award of costs at the conclusion of the proceedings, which will normally be based on the published scale of costs.”

In approaching the award of costs, I bear in mind that the evidence filed by the opponent was of no assistance to me. I award costs on the following basis:

Preparing notice of opposition and considering a counterstatement:	£300
Opposition fee:	£200
Preparation for and attendance at the hearing:	£300
<b>Total:</b>	<b>£800</b>

68) I order Obshchestvo s ogranichennoj otvetstvennost'ju “BANK FININVEST” to pay Finanziaria d'Investimento Fininvest S.p.A. the sum of **£800**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11th day of February 2014**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**